

REMARKS

This Amendment is in response to the non-final Office Action mailed November 3, 2004. Claims 1 to 35 are pending in this application. Claims 1 to 10, 13, 15, 16, 20, 23, 24, 26 and 30 stand rejected. Claims 1, 13 and 30 are being amended herein. No new matter has been added by any of the amendments. It is believed that no fee is due in connection with this Amendment. However, please charge any additional fees associated with this Amendment to Deposit Account No. 02-1818.

In the present Office Action, the drawings were objected to as not adequately showing how the overvoltage protector serves as one of the terminals. Applicant respectfully submits that, e.g., Figs. 6 and 7 show a thyristor 302 forming a Terminal C, Fig. 8 shows a thyristor 619 forming a Terminal C, and Figs. 15 to 20 also show overvoltage devices having portions clearly labeled, which serve as terminals. The corresponding written description also clearly describes the claimed features shown in Figs. 6 to 8 and 15 to 20.

Submitted with this response is a set of formal drawings, which may also aid the Patent Office in determining that the claimed features are clearly shown. If the Examiner determines that further clarification is necessary, Applicant respectfully requests that Examiner contact the undersigned. Also provided is a pair of replacement sheets showing changes to Figs. 15 and 22. The changes to Fig. 15 are supported by the original Fig. 15 and the written description at page 15, line 29. The change to Fig. 22 is supported by the written description at page 17, line 11.

In the Office Action, Claims 1 and 13 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,178,080 to Wilken et al. ("*Wilken*"). Claims 1 to 10, 13, 15, 16, 20, 23, 24, 26 and 30 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,407,901 to Casey et al. ("*Casey*").

Regarding the rejection of Claims 1 and 13 in view of *Wilken*, *Wilken* does not teach a device with an overvoltage protection portion, in which part of the overvoltage protection portion is conductive and serves as a terminal. *Wilken* instead describes its equipment protection arrangement as having an electrical line with at least two conductors, and an overvoltage protector having a first end coupled to one of those conductors (See *Wilken*, col. 2, lines 56 to 61). *Wilken* does not disclose how the overvoltage protection device is actually coupled to the

electrical line. Moreover, *Wilken* does not teach or suggest that part of the overvoltage protection device has a conductive portion and serves as one of the terminals.

The Patent Office cites *Wilken*, col. 7, lines 10-20 and corresponding Fig. 11 for the proposition that part of the overvoltage protection portion serves as one of the plurality of terminals. This section appears only to state that the overvoltage protection device and the overcurrent device may be packaged together. Merely being in an integrated package is not enough to teach the structure of Claims 1 and 13. Fig. 11 indeed is schematic in nature. It does not appear that *Wilken* is concerned with the physical layout of its device. Applicant believes the teachings of *Wilken* are being stretched improperly to teach the claim. Applicant respectfully submits that *Wilken* does not teach or suggest all of the elements of Claims 1 and 13 and that those claims as well as Claims 2 to 12 and 14 to 27 that depend respectively from Claims 1 and 13 are patentable over *Wilken*.

Regarding the rejection of Claims 1, 13 and 30 under *Casey*, Claims 1, 13 and 30 as presently presented each provide an overvoltage protection element having a part that is conductive and which serves as a terminal of a plurality of terminals. *Casey* provides a semiconductor device that includes both overvoltage and overcurrent protection. Similar to the *Wilken* reference, however, and in contrast to the claimed invention, *Casey* fails to disclose or even suggest the desirability of an overvoltage protection device in which part of the overvoltage protection portion is conductive and serves as one of the terminals. Contrary to the Office Action, the terminals 30 or 32 of *Casey* are not part of the overvoltage protection portion (See *Casey*, Fig. 1). Rather, the overvoltage protection portion is provided by the integrated circuits 40 and 41 between pins 30 and 32, which are connected to the respective telephone line tip and ring conductors (See *Casey*, col. 5, lines 43 to 45). The pins serve as the terminals for the *Casey* device and are not a part of the overvoltage protection portion. For at least these reasons, *Casey* is deficient with respect to the claimed invention. Applicant therefore respectfully submits that independent Claims 1, 13 and 30 and claims 2 to 12, 14 to 29 and 31 to 35 that depend respectively therefrom are patentable over *Casey*.

For the foregoing reasons, Applicant submits that the present application is in condition for allowance and earnestly solicit reconsideration of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett

Reg. No. 30,142

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4204

Dated: January 3, 2005

Amendments to the Drawings:

The attached sheets of drawings includes changes to Figures 15 and 22. These sheets replace the original sheet including Figure 15 and the original sheet including Figure 22.

Attachment: Replacement Sheets